



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,627	12/28/2000	Surendra Goel	06975-147001/ Search 03	5980

26171 7590 08/03/2006

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
----------	--------------

2141

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/749,627	Applicant(s) GOEL ET AL.	
	Examiner Kristie Shingles	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claims 1-23 are pending.

Response to Arguments

1. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.
2. In view of the Appeal Brief filed on 5/11/2006, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is a non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendment, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 101 Utility

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 18 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The limitations of “a propagated signal” and “a carrier wave”, constitute as a form of energy per se, and are therefore non-statutory. Correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-8, 10-19 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Singhal* (US 6,370,527) in view of *Kumar et al* (US 6,278,993).

a. **Regarding claim 1**, *Singhal* teaches a method for displaying web site search results obtained from searching multiple electronic information stores without distinguishing the particular electronic information stores in the display, the method comprising:

- receiving at least one search term and storing internal content at a web host (col.3 lines 30-53, col.4 lines 45-57);
- comparing, at the web host, the search term with first electronic information within a first electronic information store to determine whether matches exist, the first electronic information including the internal content provided by the web host; comparing the search term with second electronic information within a second electronic information store to determine whether matches exist, the second electronic information including content provided by a source other than the web host (Abstract, col.1 lines 34-41); and

- displaying results based on the matches that are determined to exist with the first electronic information and the second electronic information, wherein the results are displayed in a single interface of results comprised of the matches that are determined to exist with the first electronic information and the second electronic information (col.2 lines 17-28, col.4 lines 45-57).

Yet *Singhal* fails to explicitly teach the first electronic information including the internal content provided by the web host and being made accessible only to members of the web host and the second electronic information including content provided by a source other than the web host and being made accessible to both the members of the web host and non-members. However, *Kumar et al* disclose a first search function for returning search results from user-subscribed sites, while a second search function returns search results from general search engines where subscriptions are required; search results from both search functions are returned to the client's computer for display (col.4 lines 35-40, col.13 lines 34-40, col.21 line 24-col.22 line 35, col.23 line 49-col.24 line 58, col.25 line 12-col.26 line 37, col.26 line 55-col.27 line 67, col.28 line 30-col.29 line 57). Furthermore, *Kumar et al* teach receiving at least one search term and storing internal content at a web host (col.27 line 56-col.28 line 4, col.29 lines 5-17 and 24-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Singhal* and *Kumar et al* for the purpose of permitting access to private (members only) and public (any user) electronic information retrieved by private and public search resources because it allows for more extensive search abilities and comprehensive search results; wherein deeper, more exhaustive searching services are extended to members/subscribers of particular web hosts.

b. **Claims 8 and 17** contain limitations that are substantially equivalent to claim 1 and are therefore rejected under the same basis.

c. **Regarding claim 3**, *Singhal* and *Kumar et al* teach the method of claim 1, *Singhal* further teaches wherein: receiving at least one search term comprises receiving several search terms and grouping the search terms received as a single string (col.5 lines 40-42, col.6 lines 30-37 and 54-61; *Kumar et al*: col.3 lines 23-28, col.21 lines 50-58); comparing the search term with the first electronic information comprises comparing the single string of search terms with the first electronic information to determine whether matches exist; and comparing the search term with the second electronic information comprises comparing the single string of search terms with the second electronic information to determine whether matches exist (Abstract, col.1 lines 34-41; *Kumar et al*: col.21 line 52-col.22 line 16).

d. **Regarding claims 4 and 12**, *Singhal* and *Kumar et al* teach the method of claim 1 and 8, *Singhal* further teaches wherein the first electronic information further includes proprietary web content such that comparing the search term with the first electronic information includes comparing the search term with the proprietary web content within the first electronic information store to determine whether matches exist (Abstract, col.1 lines 34-41, col.5 lines 4-7, col.6 lines 5-14; *Kumar et al*: col.25 line 64-col.26 line 5).

e. **Regarding claims 5 and 13**, *Singhal* and *Kumar et al* teach the method of claim 4 and 12 wherein the second electronic information further includes non-proprietary web content such that comparing the search term with the second electronic information includes comparing the search term with the non-proprietary web content within the second electronic information

Art Unit: 2141

store to determine whether matches exist (Abstract, col.1 lines 34-41, col.5 lines 4-7, col.6 lines 5-14; *Kumar et al.*: col.25 line 64-col.26 line 5, col.26 line 55-col.27 line 2, col.28 lines 30-40).

f. **Regarding claims 6 and 16,** *Singhal* and *Kumar et al* teach the method of claim 1 and 8, *Singhal* further teaches the method of claim 1 and 8 wherein the results include a ranked list of web site identifiers (col.4 lines 45-57, Figure 7; *Kumar et al.*: col.29 lines 35-42).

g. **Regarding claim 7,** *Singhal* and *Kumar et al* teach the method of claim 6 wherein the results from the matches determined to exist with the internal content from the web host are ranked higher than the results from the matches determined to exist with the content from the source other an the web host (col.1 lines 42-49, col.5 lines 4-7, col.6 lines 5-14; *Kumar et al.*: col.29 lines 35-42).

h. **Regarding claim 10,** *Singhal* and *Kumar et al* teach the method of claim 8, *Singhal* further teaches wherein the second electronic information within the second electronic information store is maintained by the third party search service (col.1 lines 17-27, col.3 lines 5-11, Figure 1; *Kumar et al.*: col.27 lines 17-25 and 37-67).

i. **Regarding claim 11,** *Singhal* and *Kumar et al* teach the method of claim 8, *Singhal* further teaches wherein displaying the first results and the second results includes integrating the first results and the second results without displacing (col.29 lines 43-57).

j. **Regarding claim 14,** *Singhal* and *Kumar et al* teach the method of claim 13 wherein the second electronic information includes information that is proprietary to the third party search service (Abstract, col.1 lines 34-41, col.5 lines 4-7, col.6 lines 5-14; *Kumar et al.*: col.27 lines 17-25 and 37-67).

k. **Regarding claim 15**, *Singhal* and *Kumar et al* teach the method of claim 8, *Singhal* further teaches wherein the first electronic information within the first electronic information store is maintained by an internet service provider (col.3 lines 5-10; *Kumar et al*: col.21 line 1-31).

l. **Regarding claims 18 and 19**, *Singhal* and *Kumar et al* teach the computer program of claim 17, *Singhal* further teaches wherein the computer readable medium comprises a propagated signal (col.2 lines 63-65, col.3 lines 5-10).

m. **Regarding claims 21, 22 and 23**, *Singhal* and *Kumar et al* teach the methods and computer program of claims 1, 8, and 17, *Kumar et al* further teach wherein the displaying results includes: displaying results from the web host in a first section of the single interface of results; displaying results from the source other than the web host in a second section of the single interface of results, wherein the first section and the second section are physically distinct from each other (col.29 lines 43-57; *Singhal*: col.2 lines 35-42).

7. **Claims 2, 9 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Singhal* (US 6,370,527) in view of *Kumar et al* (US 6,278,993) in further view of *Navin-Chandra et al* (US 6,275,820).

Regarding claims 2, 9 and 20, *Singhal* and *Kumar et al* teach the methods and computer program of claims 1, 8, and 17 as applied above. *Kumar et al* teach that searching, navigation and returning the search results are performed transparently to the user via a single interface (col.25 lines 12-33). Yet *Singhal* and *Kumar et al* fail to explicitly teach displaying results such

that whether the results are obtained from the source other than the web host or the web host is transparent to a user viewing the single interface of results.

However, *Navin-Chandra et al* teach wherein displaying results includes displaying results such that whether the results are obtained from the external source or the internal source is transparent to a user viewing the single list of results (Abstract, column 8 lines 16-18). Therefore it would have been obvious to one of ordinary skill in the art to modify the apparatus for searching networks using a plurality of search engines of *Singhal* and *Kumar et al* by displaying results such that whether the results are obtained from the external source or the internal source is transparent to a user viewing the single list of results because this returns a more uniform and accurate ranking of results in response to the users query.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Shear et al (6,938,021), Chidlovskii et al (6,327,590), Knight et al (6,859,807).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2141

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER